

REMARKS**INTRODUCTION**

In accordance with the following, reconsideration of the pending claims is respectfully requested.

Claims 1-16 are pending, and with claims 5-13 having been withdrawn from consideration, claims 1-4 and 14-16 are under consideration.

REQUEST FOR WITHDRAWAL OF FINALITY AND NEW OFFICE ACTION

As detailed in the Request for Reconsideration filed September 15, 2004, incorporated herein by reference, the outstanding Office Action has failed to present proper obviousness rejections. The outstanding rejection rationales are based solely on the Examiner's belief that a found feature, from a secondary reference, would have been beneficial in a primary reference.

In the Request for Reconsideration, applicants particularly pointed out what the individual references disclosed, what a combination of the references would disclose, and that the record was silent as to why (or even how) one skilled in the art would make the proffered combinations. It was further pointed out that, even as modified, the combination of the references would still fail to disclose the presently claimed invention.

In the Advisory Action, mailed October 1, 2004, the Examiner would appear to have only addressed applicants' comments as to what the differing references actually disclosed. Accordingly, the Examiner has failed to address the applicants' detailed non-obviousness comments.

As noted in at least MPEP 707.07(f), the Examiner is required to answer and address all traversals. This requirement is in addition to any repetition of a previously held position and is required to allow the applicant a chance to review the Examiner's position as to these arguments and to clarify the record for appeal. However, without the Examiner's review of applicants' obviousness arguments the record is not clear as to the rationales for the outstanding rejections.

Additionally and as further noted in MPEP 707.07(f), a failure of the Examiner to address the applicant's traversals can be deemed a failure to rebut these arguments so as to admit that the arguments have overcome the rejection. At the very least, the failure to address the applicant's traversals would render the Examiner's decision to again reject the claims arbitrary and capricious and invalid under the Administrative Procedures Act, 5 U.S.C. § 706, the standard under which such rejections are reviewed in view of Dickinson v. Zurko, 527 U.S. 150, 50 USPQ2d 1930 (1999).

As such, since the Examiner has not addressed the applicant's traversals, it is respectfully requested that the Examiner withdraw the Final Office Action and issue a new Office Action addressing each traversal in the Request for Reconsideration filed September 15, 2004.

REQUESTED STANDARDS FOR NEXT OFFICE ACTION

As noted in the Request for Reconsideration, it is respectfully submitted that the outstanding rejections fail to set forth prima facie obviousness cases. Accordingly, applicants request that the next Office Action comply with the following.

First, the following is noted: "[i]t is well established that agencies have a duty to provide reviewing courts with a sufficient explanation for their decisions so that those decisions may be judged against the relevant statutory standards, and that failure to provide such an explanation is grounds for striking down the action," in addition, "an agency is not free to refuse to follow circuit precedent." In re Lee 61 USPQ2d 1430, 1434 (CA FC 2002).

Thus, the following precedent is binding in the present case.

MPEP § 2142 states that "[w]hen the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper." The Examiner is required to present actual evidence and make particular findings related to the motivation to combine the teachings of the references. In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). **Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence."** Dembiczak, 50 USPQ2d at 1617.

The Examiner must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. In re Rouffet, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

In addition, it is well settled that "the Board [and Examiner] cannot simply reach conclusions based on [their] own understanding of experience - or on [their] assessment of what would be basic knowledge or common sense. Rather the Board [and Examiner] must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F. 3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of "*common knowledge*" and "*common sense*" may only be applied to the analysis of evidence, rather than be a substitute for evidence. The court has also recently expanded their reasoning on this topic in In re Thrift, 298

F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

Accordingly, a prima facie obviousness rejection requires evidenced motivation from something in the record that would lead one skilled in the art to combine the relevant teachings, again noting that the mere fact that the prior art may be modified in a particular manner does not make the modification obvious unless the prior art suggested the desirability of that modification.

EXAMINER'S INTERPRETATION OF CLAIM LANGUAGE

Lastly, in the Advisory Action mailed October 1, 2004, the Examiner has presented an interpretation of Misso et al., U.S. Patent No. 6,424,488, which completely counters the disclosure of the same, and accordingly is counter to the common understanding of the same.

The Examiner has indicated that the term "disk" in Misso et al. can be considered inclusive of both the actual disk and the disclosed disk ring, such that when Misso et al. etches the disk ring the same can be read on the claimed etching of "the disk."

However, Misso et al. particularly differentiates between "the disk" and the "disk ring." Misso et al. explains that the disk ring is added to an outer periphery of the disk, i.e., the disk ring is not part of the disk.

In addition, Misso et al., in col. 3, lines 4-25, sets forth in detail that the disk rings are made of a material different from the disk, e.g., rubber. "The peripheral disc rings 140 are preferably configured to fit over the peripheral edges and outermost portions of the top and bottom surfaces of the discs 108...Each peripheral disc ring 140 is preferably elastomeric and sized appropriately so as to exert an inwardly directed spring force to retain the ring on the disc 108."

Thus, the disclosure of Misso et al. particularly differentiates between "the disk" and "the disk rings." The above recitation from Misso et al. even discusses the need to find a way to keep the disk ring on the disk.

Accordingly, as a general proposition, claim limitations are to be interpreted in light of its broadest reasonable interpretation. In re Prater, 162 USPQ 541, 550-51 (CCPA 1969), cited with approval, In re Morris, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997). Further, the claims should be interpreted in light of their plain meaning as understood by one of ordinary skill in the art. In re Zletz, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), citing, In re Prater.

However, the broadest reasonable interpretation must also conform to the broadest reasonable interpretation afforded by one of ordinary skill in the art when read in light of the specification. In re Prater, 162 USPQ 541, 550-51, In re Morris, 44 USPQ2d at 1027, MPEP 2111.01 (7th Ed., rev. 1)(Feb. 2000).

Thus, a reasonable interpretation would not counter the disclosure of the present application nor the disclosure of Misso et al., i.e., the claimed disk cannot be interpreted as being inclusive of a disk ring attached to an outer periphery of the disk.

As this interpretation of "disk" and "disk ring" would appear to be important to the viability of the outstanding rejections in the outstanding Office Action, and as the outstanding interpretation proposed in the Advisory Action would appear improper, it is respectfully requested that the outstanding rejections be withdrawn and the allowability of the claims be reconsidered.

Lastly, in the Advisory Action, the Examiner briefly noted that, though one of the references would not appear to disclose a stopping of a material and then etching but rather discloses etching while the material is rotating, regardless, the reference's etching mechanism "can be capable" of performing the etching while the material was stationary.

The Examiner is reminded that an "obvious to try" rationale for combining two references is not valid motivation under 35 USC §103. In re Goodwin, 576 F.2d 375, 377, 198 USPQ 1, 3 (CCPA 1978); In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977); In re Tomlinson, 363 F.2d 928, 150 USPQ 623 (CCPA 1966).

As noted in the previous Request for Reconsideration, it would appear that the primarily relied upon references require the etched disk to be rotating during the etching, and also appear to point out a preference for the same.

Thus, regardless of whether the etching machine of any of the references are "capable" of performing their etching operations while a disk is stopped, there must be some motivation or rationale in the record supporting the obviousness of modifying the primary references accordingly. It is respectfully submitted that there is insufficient motivation in the present record.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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